

PATENT
Atty. Docket: 58763.000013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Daniel DUPRET et al.

Serial No.: 09/840,861

Filed: April 25, 2001

Group Art Unit: 1637

Examiner: S. Hashemi

For: PROCESS FOR IN VITRO CREATION OF RECOMBINANT
POLYNUCLEOTIDE SEQUENCES BY ORIENTED LIGATION

SUPPLEMENTAL PETITION UNDER 37 CFR 1.78(a)(3)/1.55(c)
TO ACCEPT LATE CLAIM FOR PRIORITY

Mail Stop Petition
Commissioner for Patents
Alexandria, VA 22313-1450

FAX RECEIVED**APR 18 2003****PETITIONS OFFICE**

Sir:

Procedural Background

On December 24, 2002, Applicants filed a Petition Under 37 CFR 1.78(a)(3) to Accept Late Claim for Priority. On April 17, 2003, undersigned counsel spoke by telephone with Ms. Frances Hicks of the Petitions Office. Ms. Hicks said that the Petition should be characterized as a petition under both 37 CFR 1.78(a)(3) and 1.55(c) because Applicants are trying to claim priority to a prior-filed US application, a PCT application, and a French application.¹

Ms. Hicks also recommended that Applicants file three documents: (1) a supplemental petition, (2) a declaration or application data sheet that claims the benefit of priority of the aforementioned applications, and (3) a supplemental amendment to remove the reference to the French priority application from the Cross-Reference to Related Applications section of the Specification.

¹ Applicants' previous Petition incorrectly referred to the prior-filed US application as a "national stage" of the PCT application. The prior-filed US application is a 1.53(b) continuation of the PCT application.

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Applicants have complied by filing: (1) this Supplemental Petition Under 37 CFR 1.78(a)(3)/1.55(c) to Accept Late Claim for Priority, (2) an Application Data Sheet that claims priority to the aforementioned applications, and (3) a Supplemental Amendment that removes the reference to the French application from the Cross Reference to Related Applications section of the Specification.

Applicant is filing the Application Data Sheet and the Supplemental Amendment by hand in the Clerk's Office today. Copies are attached to this Petition. To prevent the Application Data Sheet and Supplemental Amendment from being filed twice, the attached copies are marked NOT FOR FILING.

Merits of the Petition

Applicants failed to claim the benefit of three prior-filed applications, which are: US Application No. 09/723,316, filed November 28, 2000; PCT Application No. FR99/01973 (WO00/09679), filed August 11, 1999; and France App No. 98/10338, filed August 12, 1998.

Pursuant to Rule 1.78(a)(3), Applicants request acceptance of a late claim for benefit of the filing dates of the above US and PCT applications. Pursuant to Rule 1.55(c), Applicants also request acceptance of a late claim for benefit of the filing date of the above French application.

Rule 1.78(a)(3) and 1.55(c) authorize acceptance of delayed claims for priority as long as the delay was unintentional. The delay was unintentional in this case. Although the exact circumstances are unclear, the delay clearly resulted from an oversight related to the resemblance of the above-captioned application to the prior-filed US application (the '916 application) and perhaps also to the Applicants' provisional application 60/285,998.

The '316 and '998 applications are both entitled "Process for Obtaining Recombined Polynucleotide Sequences In Vitro, Libraries of Sequences and Sequences Thus Obtained." As originally filed, the above-captioned application was entitled "Process for In Vitro Creation of Recombinant Polynucleotide Sequences by Oriented Ligation." However, from immediately after the above-captioned application was filed until December 2002, Applicants' filings in the above-captioned application incorrectly used the title of the '316 and '998 applications. Applicants have concluded, therefore, that they inadvertently confused the above-captioned application with the '316 and '998 applications.

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As required by Rule 1.78(a)(3)(ii) and 1.55(c), the surcharge of \$1240.00 listed in Rule 1.17(t) was attached to Applicants' previous Petition filed on December 24, 2002. No additional fees are believed to be required. If any fees are required, please charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

Date: April 18, 2003By: 

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